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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the application of:

Dyson Limited

Mark:



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**REPLY BRIEF OF APPLICANT
DYSON LIMITED**

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INTRODUCTION

For the reasons set forth in Applicant's Appeal Brief and further elaborated below, the relevant factors outlined in *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-41, 213 U.S.P.Q. 9, 15-16 (C.C.P.A. 1982), weigh in favor of registration of Applicant's trade dress. First, Applicant's utility patents and utility patent applications themselves make clear that the trade dress at issue here is merely one possible embodiment of the patented technology. Moreover, none of them discloses the utilitarian advantages of the trade dress as a whole. Second, Applicant respectfully submits that the Examining Attorney has mischaracterized Applicant's advertising as well as third-party descriptions of Applicant's product. Furthermore, none of the sources cited by the Examining Attorney touts the utilitarian advantages of the trade dress as a whole. Third, the evidence of alternate designs submitted by Applicant and the existence of nearly identical registered design patents weigh in favor of finding the applied-for trade dress non-functional. Taken together, Applicant respectfully submits that these factors weigh against a finding of functionality. The trade dress should proceed to publication.

LEGAL ARGUMENT

In determining functionality, the asserted trade dress must be analyzed *as a whole*, and not by its individual elements. 15 U.S.C. § 1052(e)(5). The Federal Circuit has cautioned against "[s]imply dissecting [the] alleged trademark into its design features and attributing to each a proven or commonly known utility." *In re Teledyne Indus. Inc.*, 696 F.2d 968, 971, 217 U.S.P.Q. 9, 11 (Fed. Cir. 1982). "Rather, the decisive consideration is whether the *overall design*" of the applied-for trade dress is functional. *Id.* (emphasis added). Applicant respectfully submits that the Examining Attorney engaged in the method of analysis disfavored by the Federal Circuit in *Teledyne*. Rather than considering the overall design, the Examining

Attorney dissected the applied-for trade dress into distinct design elements and attributed a utility to each based upon isolated statements from one of Applicant's utility patents or utility patent applications.

The Examining Attorney's incorrect analysis starts with her focus on "what the applicant has claimed." (*See* Examiner's Brief at 2.) To determine what Applicant "claims," she refers to Applicant's description of the trade dress and identifies four elements: a circular ring, a column-shaped base, inlets, and buttons. (*Id.*) By dissecting Applicant's trade dress in this fashion, Applicant has converted the trade dress into a checklist of design concepts that she treats as Applicant's "claim." But the written description of the trade dress, required by TMEP § 1202.02(c)(ii), does not "claim" specific aspects of the trade dress in the way that patents "claim" specific inventions. Instead, it is merely a concise description of the mark that should be written succinctly to "capture the essence of the mark." *See* TMEP § 808.02.

There is, in fact, no requirement that the description must include every aspect of a trade dress. *See id.* ("[W]hen a mark contains a substantial number of design elements, it may only be necessary to generally state in the description those elements that capture the essence of the mark."). Because the description need not include all design elements, it is improper to limit an applied-for trade dress to the list of design elements included in the description. Not only is there no support for the Examining Attorney's limitation of Applicant's trade dress to a list of elements found in the description of the mark, but that approach also contradicts the *Trademark Manual of Examining Procedure*, which makes it clear that the drawing, not the description, defines the mark to be registered. *See* TMEP § 807 ("The drawing shows the mark sought to be registered.... The main purpose of the drawing is to provide notice of the nature of the mark sought to be registered."). Because the functionality analysis concerns not just a few aspects of

the trade dress, but the trade dress “as a whole” (15 U.S.C. § 1052(e)(5)), as depicted in the drawing, the Examining Attorney’s analysis must be rejected.

I. APPLICANT’S UTILITY PATENTS AND UTILITY PATENT APPLICATIONS DO NOT CLAIM A UTILITARIAN ADVANTAGE FOR THE TRADE DRESS AS A WHOLE

Although Applicant believes the correct method of analysis is to consider the overall trade dress as a whole, which leads to the conclusion that the trade dress is not functional as explained in Applicant’s opening brief, it responds here to the Examining Attorney’s consideration of four identified design elements.

A. The Circular Ring

Significantly, with respect to the circular ring at the top of the fan—called a “nozzle” in Applicant’s utility patents and utility patent applications—the Examining Attorney points to language in the utility patents and utility patent applications that she believes establishes that the shape of the nozzle is functional (Examiner’s Brief at 3-4), but she ignores other language in the patents and patent applications that makes it clear that there are a multitude of design options for the nozzle. Moreover, having highlighted claim language that refers to the nozzle as “substantially annular,” “at least partially circular,” and in the form of a “loop,” the Examining Attorney states that “[i]t is enough that the elements sought to be registered appear in the patent claims, and that their utilitarian functions are described” and then points to such alleged descriptions in the patents. (*Id.*) The Examining Attorney, however, cites to no case law to support this simplistic analysis, and her piecemeal approach makes it clear why her approach is not sufficient.

Instead of looking at the utility patents and applications as a whole, the Examining Attorney extracts specific terms from the claims (“substantially annular,” “at least partially

circular,” and “loop”) and attempts to link them to other language that she believes establishes that they are functional, and concludes that the circular ring element must be functional. As an initial matter, the patents claim a nozzle that is “substantially annular,” “at least partially circular,” and in the form of a “loop,” language which could encompass a variety of shapes, such as an oval or egg shape. Here, the applied-for trade dress depicts a circular ring. Even if the cited claim language were limited to the shape of the applied-for trade dress, however, the analysis is faulty because the language to which the Examining Attorney cites to prove that the shape is functional—“By providing an annular nozzle the fan can potentially reach a broad area” and “the nozzle ‘can be manufactured as a single piece, reducing the complexity of the fan assembly and thereby reducing manufacturing costs’” (Examiner’s Brief at 4)—is taken out of context.

The paragraph in which those sentences are found gives context to them:

Preferably the nozzle comprises a loop. The shape of the nozzle is not constrained by the requirement to include space for a bladed fan. In a preferred embodiment the nozzle is annular. By providing an annular nozzle the fan can potentially reach a broad area. In a further preferred embodiment the nozzle is at least partially circular. This arrangement can provide a variety of design options for the fan, increasing the choice available to a user or customer. Furthermore, in this arrangement the nozzle can be manufactured as a single piece, reducing the complexity of the fan assembly and thereby reducing manufacturing costs. Alternatively, the nozzle may comprise an inner casing section and an outer casing section which define the interior passage, the mouth and the opening. Each casing section may comprise a plurality of components or a single annular component.

(U.S. Patent No. 7,931,449 col.3 l.61-col.4 l.8.)

To start, the ’449 Patent clearly states that it is preferable that the nozzle comprise “a loop.” A loop is not necessarily a circular ring; it is any curved shape that bends around and crosses itself so that it is closed. The patent then goes on to say that the shape of the loop (the nozzle) is *not* constrained by the requirement to include space for a bladed fan. So any shape of

loop can be used. It can be an oval. It can be a circle. It can be an egg shape. The patent then describes the types of loops that are preferred—they can be “annular” or they can be “at least partially circular.” With respect to the former, the patent merely states that it can “potentially” reach a broad area; it does not say that it will do so. The mere possibility that something could happen surely does not render a specific design functional. With respect to “partially circular” loops, the patent touts “a variety of design options” and the resulting increase in customer choice. There is nothing to suggest that these alternative loops do not have the potential to reach the same area as an annular loop. Moreover, the language to which the Examining Attorney points claims that the circular ring in the trade dress creates an ease of manufacture is not even tied to a circular ring; instead, it refers to loops in general, which is not the subject of the pending application.¹

In sum, the patent itself acknowledges that the circular ring shape is an incidental feature of the design, and that a variety of design options can achieve the principal teachings of the patent. As Applicant explained in its Opening Brief, other patents as well as testimony of a Dyson designer confirm that the exterior shape of the top portion of the fan does not affect the function of the internal nozzle. (*See* Applicant’s Opening Brief at 5-6.)

B. The Column-Shaped Base

With respect to the column-shaped base, the Examining Attorney cites to language in Applicant’s utility patents and utility patent applications that describe a “cylindrical” base. (Examiner’s Brief at 4-5.) But, as with the nozzle, the patents make clear that shape is not necessary for the functioning of the fan. For example, U.S. Patent Publication No.

¹ The Examining Attorney states that U.S. Patent No. 8,403,650 “contains almost identical language” to the language quoted above from the ’449 Patent. (Examiner’s Brief at 4.) In fact, the ’650 Patent clearly attributes the manufacturing benefit to the fact that “the interior passage is continuous,” not that the nozzle is “partially circular” or “substantially annular,” let alone perfectly circular like the ring in the applied-for trade dress. (’650 Patent col.3 l.66–col.4 l.3.)

2010/0226787 states that “[i]n a preferred embodiment the outer surfaces of the base and the body have substantially the same profile. For example, the profile of the outer surfaces of the base and the body may be substantially circular, elliptical, or polyhedral.” (*Id.* at para. [0016].) The Examining Attorney suggests that the patent application states a cylindrical base has the utilitarian advantage of being able to be wiped clean. But a careful reading of the patent reveals that it is not the shape of the base that bestows this advantage, but rather a configuration where the “adjoining portions of the outer surface are substantially flush when the body is in the untilted position.” (*Id.* at para. [0012].) The adjoining portions of the outer surface can be flush with each other on a variety of differently shaped bases. Moreover, different designs can offer more or different functionalities than the applied-for design. For example, the whole base unit could be proportionally larger with a greater diameter, which would increase the stability of the fan, but still offer a substantially flush surface. Thus, the column-shaped base with the proportions shown in the applied-for trade dress is an ornamental, not utilitarian, feature of the design.

C. The Inlets and Buttons

As for the inlets and buttons on the base of the fan, the utility patents do not disclose the utilitarian purpose of those elements as shown in the applied-for trade dress. While the air inlets embedded in the base of the fan admittedly perform the function of allowing air to be drawn into the fan, no utility patent discloses the particular arrangement of inlets in a series of rectangular blocks shown in the applied-for trade dress. Instead, the utility patents and patent applications show a continuous air inlet around the entire circumference of the base. (*See, e.g.*, U.S. Patent Publication No. 2010/0226787 fig. 1; U.S. Patent Publication No. 2012/0082561 fig. 1; U.S. Patent No. 7,972,111 fig. 1.) The series of rectangular blocks which form the pattern of air inlet

holes in the applied-for trade dress were selected at least in part for aesthetic reasons. The manufacturing process requires the use of very expensive plastics injection molding tools to create the rectangular block shapes. There are very many alternative arrangements which could have been selected, many of which would have been much less expensive to manufacture.

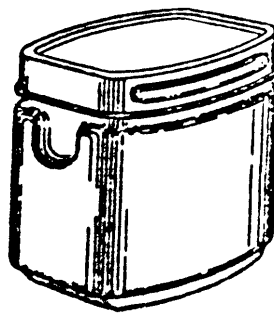
Similarly, while the buttons on the base of the fan admittedly perform the function of allowing the device to be activated, that does not mean their appearance in the applied-for trade dress is not ornamental. Here, the buttons are circular, echoing the shape of the top portion of the fan, and two buttons are recessed into the base of the fan so that they are flush with the rest of the surface of the base. This emphasizes the sleek, uncluttered look of the overall design. The utility patents and patent applications cannot and do not claim any functional purpose for this specific array of buttons.

D. The Patents Do Not Establish That the Overall Trade Dress Is Functional

Regardless of whether or not some individual aspects of Applicant's design may serve a utilitarian purpose, as stated above the correct inquiry is whether the design as a whole is functional. An overall design may still be ornamental even if some of its individual elements are functional. "[A]n overall design combination of individually functional items is protectable because while the pieces are individually functional, [a] particular combination of those pieces is not functional. Almost all courts adhere to this view. There is little dissent from this position."¹ *McCarthy on Trademarks and Unfair Competition* § 7:76 (4th ed.). This was the conclusion reached by a U.S. District Judge who concluded Applicant's identical design patents were not functional because, although individual elements of the design served a utilitarian purpose, the overall combination of elements was ornamental. (See Applicant's Opening Brief at 8.) The Examining Attorney calls the relevance of the district court case into question because "[t]he

applicant has not submitted a final opinion, based on a fully briefed case.” (See Examiner’s Brief at 11.) The procedural posture of the court’s order does not diminish its persuasiveness. Based on a fully briefed preliminary injunction motion and a hearing that included testimonial evidence, and in spite of Plaintiff’s strenuous arguments that Applicant’s designs were functional, the court concluded that Applicant’s overall design was not functional and entered a preliminary injunction prohibiting the sale of Cornucopia’s fans in the United States.

In re Chesebrough-Pond’s Inc., 224 U.S.P.Q. 967, 1984 WL 63177 (T.T.A.B. Oct. 31, 1984) is illustrative. There, the applicant sought to register the design for a petroleum jelly container that had flattened ends, a wide mouth, and grooves to facilitate opening the cap, shown below:



Id. at 224 U.S.P.Q. at 967, 1984 WL 63177, at *1. Although the Board found that some aspects of the design indeed had a utilitarian purpose, such as the “indentations for gripping [that] may be functional advantages when dealing with a greasy substance” like petroleum jelly, the Board concluded the overall design was not functional. “[W]e conclude that while applicant’s jar performs its primary function in an admirable way there is nothing to indicate that the design has such superiority over other possible designs that competitors need the freedom to copy it in order to compete effectively with applicant.” *Id.* at 224 U.S.P.Q. at 968, 1984 WL 63177, at *3. The same is true here.

II. DYSON’S ADVERTISING AND THIRD-PARTY DESCRIPTIONS OF THE DESIGN REFER TO THE CIRCULAR RING BUT DO NOT TOUT ITS UTILITARIAN ADVANTAGES

The Examining Attorney relies on the fact that several third-party descriptions of the fan embodying the applied-for trade dress note that the nozzle portion of the fan is “annular” or shaped like a “ring.” But accurately describing the appearance of the product is not the same thing as attributing the performance of the product to that specific design element. The mere fact that these articles use the word “ring” or “annular” to describe the shape of the top of the fan does not mean they are touting the utilitarian advantages of the ring shape.

For example, the Examining Attorney relies on the Wikipedia entry for bladeless fans, and notes that the entry states “[a] bladeless fan blows air from a *ring* with no blades” and “[t]he air goes into the base. It is then sent up into a *ring*.” (Examiner’s Brief at 9, emphasis in the original, internal quotations omitted.) The entry (which purports to describe bladeless fans in general, not Applicant’s product in particular) does not state how the ring shape improves the functioning of the fan, or imply that if the bladeless part of the fan were another shape the fan would perform differently. The entry is merely using the word “ring” to identify the bladeless nozzle of the fan, not to tout the utilitarian advantage of that particular shape. Similarly, a *Time* magazine article on the Dyson fan, which describes a “*circular* low pressure region” emerging from the nozzle which creates “a fairly uniform flow of air through the *ring*,” accurately describes the shape of the nozzle, but does not emphasize the importance of the ring shape to the fan. (*Id.* at 9, emphasis in the original.) The article suggests the flow of air is uniform because the fan is bladeless, and the flow of air through the tiny slots on the interior of the nozzle create a low pressure region, not because the nozzle is circular. (*Id.*) The Dyson advertisement cited by the Examining Attorney merely shows a depiction of the fan and states “surrounding air drawn into airflow.” (*Id.* at 10.) That is an accurate description of the fan’s function. But it does not

attribute that function to the circular shape of the nozzle, much less to the overall design of the fan as a whole.

Instead of highlighting any functional advantage of the design of the fan, Dyson's own advertising seeks to emphasize the sleek, minimal Dyson design aesthetic. Many Dyson ads simply show the product standing alongside other Dyson products, without any descriptive text. The effect of these ads is to draw consumers' attention to the distinctive and futuristic look of Dyson products. (*See, e.g.*, Exhibits 6 and 7 to Applicant's Opening Brief.) For these reasons, the second *Morton-Norwich* factor does not support the Examining Attorney's conclusion that the applied-for trade dress is functional.

III. THE EXISTENCE OF NUMEROUS ALTERNATIVE DESIGNS AND TWO REGISTERED DESIGN PATENTS ALSO WEIGH IN FAVOR OF FINDING THE DESIGN NON-FUNCTIONAL

The Examining Attorney dismisses as "not relevant" evidence in the record documenting the existence of numerous alternative designs because she believes that the patents disclose that the applied-for trade dress is functional. (*See* Examiner's Brief at 10 ("As noted above, U.S. Pats. 7,931,449 and 8,403,650 state that the circular design means that the nozzle 'can be manufactured as a single piece, reducing the complexity of the fan assembly and thereby reducing manufacturing costs.'")) However, as explained above, the Examining Attorney has misinterpreted the cited patents.

The patents never state that the "circular ring" in the applied for trade dress "means that the nozzle 'can be manufactured as a single piece, reducing the complexity of the fan assembly and thereby reducing manufacturing costs,'" as claimed by the Examining Attorney. Instead, they state that all "loop" designs, regardless of shape, have this advantage. There is nothing to suggest that a circular loop reduces the complexity of fan assembly even more than an oval loop, an egg-shaped loop, or any other loop. Moreover, there is nothing in the patents to suggest that a

circular loop is less expensive to manufacture than other type of loop. Accordingly, the Board can and should consider evidence of alternative designs in determining whether the applied-for trade dress is functional.

Applicant has submitted evidence of other bladeless electric fans with nozzles in the shapes of hearts, apples, ovals, triangles, and pentagons. (*See* Exhibit 12 to Applicant's Opening Brief.) Other bladeless electric fans have differently shaped bases, including a squat, triangular base, a large, square base narrowing into a smaller cylinder, and a wide, circular base whose footprint is wider than the nozzle. (*Id.*) Still other fans reject the sleek, minimal look of the Dyson fan and incorporate features on the outside of the fan, such as headphones or ears. (*Id.*) These numerous alternate designs make clear Applicant's design is not essential to competition. *See In re Brayco Prods., Ltd.*, 2009 WL 4329104 (T.T.A.B. Nov. 16, 2009) (finding flashlight design not functional when numerous other alternative designs existed). This *Morton-Norwich* factor weighs in favor of finding the design not functional.

The Examining Attorney also discounts the existence of Dyson's design patents for designs indistinguishable from the applied-for trade dress because of her mistaken belief that the utility patents disclose that a circular nozzle reduces "the complexity of the fan assembly and... manufacturing costs." (Examiner's Brief at 4.) While the existence of design patents alone may be insufficient, without more, to find a trade dress non-functional, they "presumptively indicate[] that the design is not de jure functional." *In re Morton-Norwich Prods.*, 671 F.2d at 1342, n.3., 213 U.S.P.Q. at 17, n.3.

Applicant submits these factors also weigh in favor of allowing Applicant's trade dress to proceed to registration.

CONCLUSION

Because Applicant's applied-for trade dress is not functional, Section 2(e)(5) of the Lanham Act does not prohibit registration of the mark.

Respectfully submitted,

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